

REMARKS

This paper is responsive to an Office Action dated November 3, 2005. Prior to this amendment claims 1-6, 8-20, and 22-26 were pending. After amending claims 1-6, 8-16, 18-20, 23-24, and 26, claims 1-6, 8-20, and 22-26 remain pending.

Section 2 of the Office Action objects to claim 4. Claim 4 has been amended to remove the objection.

Claims 1-6, 8-20, and 22-26 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In response, the claims have been amended for additional clarity.

Section 5 of the Office Action states that claims 1-5, 12-19, and 25 have been rejected under 35 U.S.C. 102(e) as anticipated by Carcerano et al. ("Carcerano"; US 6,308,205). With respect to claims 1 and 15, The Office Action states that Carcerano describes building a GUI representing available devices, and querying devices after building the GUI. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

At col. 2, ln. 46-54, Carcerano describes a web browser that sends a request to network device. At col. 11, ln. 38-51, Carcerano describes a browser-based network management system that sends URL-encoded requests to obtain and monitor the status of network devices. At col. 14, ln. 47-77, Carcerano describes Steps 811 and 812 of Fig. 8B.

These steps describe receiving a HTTP response and receiving configuration data. The above-mentioned passages are cited in the Office Action as evidence that Carcerano describes the building of a GUI. However, these cited passages do not mention a GUI, or any terms similar to GUI.

In the description of Fig. 7, Carcerano does describe a "browser interface". More specifically, Carcerano describes an example where a browser 83 accesses a server 103 to obtain device status for a printer 125. The browser interface 121 is generated in response to receiving the requested information from the server (col. 12, ln. 62 through col. 13, ln. 4). This process can clearly be seen in Fig. 9, where Step 903 sends a request to a network device. Only after a response is received in Step 904 does Step 905 generate a visual display (col. 15, ln. 43 through col. 16, ln. 3).

Claims 1, 13, and 15 of the claimed invention describe initially building a GUI representation of network-connected devices. Only after building the GUI does the querying device send a query to network-connected devices. Carcerano does not build his browser interface prior to sending device status inquiries. Therefore, he does not explicitly describe every limitation of claims 1, 13, and 15. Since Carcerano does not describe every limitation of the claimed invention, he cannot anticipate. Claims 2-5 and 12, dependent from claim 1, claim 14, dependent from claim 13, and claims 16-19 and 25, dependent from claim 15, enjoy the same distinctions from the Carcerano reference, and the Applicant respectfully requests that the rejection be removed.

In Section 17 of the Office Action claims 6, 8-11, 20, 22-24, and 26 have been rejected under 35 U.S.C. 103(a) as unpatentable with

respect to Carcerano, in view AAPA. With respect to claims 6 and 20, the Office Action states that Carcerano fails to teach a timeout period, but that it would have been obvious to combine the timeout taught in the AAPA with Carcerano "to provide a more efficient way of querying multiple devices ..." With respect to claims 9-10 and 23-34, the Office Action states that it would have been obvious to combine references to "provide a method of querying devices for status information by labeling a device as available if a device replies to a query and unavailable if the device fails to respond." This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

As noted in the Background Section of the Applicant's specification (page 2, ln. 8-20), it takes as long as 30 seconds for a time-out to occur, if a device does not respond to a query. Due to the time-out problem, status updates that are delayed as long as 30 seconds.

With respect to the *first prima facie* requirement needed to support a case of obviousness, there must be some suggestion to combine

the prior art references in a manner that makes the claimed invention obvious. The fact that the combination of references would provide for a more efficient process, as stated on page 8 of the Office Action, does not support the first *prima facie* requirement. In fact, this kind of retrospective analysis would permit any two references to be combined merely as the result of a keyword search. Even worse, page 11 Office Action retroactively recites the limitations of the Applicant's claims as a rationale to support a case of obviousness. The motivation to combine references cannot be based upon the claimed invention limitations. Rather, the Office Action must provide a rationale for why the AAPA suggests any kind of modification to Carcerano.

The second *prima facie* requirement addresses the same issue from another point of view. Even if an expert were given the two references as a starting point, there is no reasonable expectation that this expert would come up with the claimed invention. Since neither of the references describe the limitations of claims 1 and 15, it is difficult to image how an expert could derive the claimed invention by combining the references.

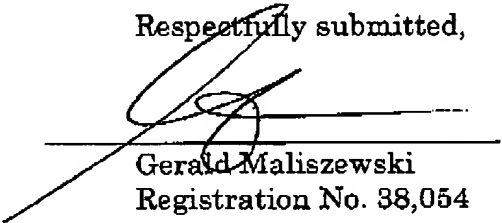
With respect to the third requirement to support a *prima facie* case of obviousness, the combination of references does not teach all the limitations of claims 1 and 15. As noted above in response to the anticipation rejection, claims 1 and 15 recite building a GUI representation of network-connected devices, and only after building the GUI, sending queries to the devices to determine their status. Both Carcerano and the AAPA only describe building a GUI after all the device query responses are received. Thus, the combination of the AAPA with Carcerano does not explicitly teach all the limitations of claims 1 and

15. Neither do the references suggest any modifications that make these claims obvious. Claims 6 and 8-11, dependent from claim 1, and claims 20, 22-24, and 26, dependent from claim 15, enjoy the same distinctions, and the Applicant respectfully requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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